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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.              | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------------|------------------------|
| 10/572,419  | 03/20/2006  | Gianfranco Passoni   | NIRSP177                         | 1171                   |
| 20210 7590 12/19/2008<br>DAVIS & BUJOLD, P.L.L.C.<br>112 PLEASANT STREET<br>CONCORD, NH 03301 |             |                      | EXAMINER<br>PARADISO, JOHN ROGER |                        |
|   |             |                      | ART UNIT<br>3721                 | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>12/19/2008          | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/572,419 | <b>Applicant(s)</b><br>PASSONI, GIANFRANCO |  |
|                              | <b>Examiner</b><br>John Paradiso     | <b>Art Unit</b><br>3721                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49-51 and 53-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-51 and 53-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 49-51 and 53-66 are rejected under 35 U.S.C. § 103(a) as being unpatentable over MILLER (US 4524691) in view of BELEC ET AL (US 5447015) and BUTTON ET AL (US 6199348), as set forth in paragraph 3 of the previous Office Action and reprinted below for convenience:

MILLER discloses a method and apparatus for opening envelopes and inserting items therein. Envelopes are held in a magazine (29) (see Fig. 6) where they are grabbed by a rotating cam (47) (see column 5:25-28), pulled off the cam and rotating drum (36) by means of a stripper bar (see Fig. 6), and conveyed to a filling station.

MILLER does not disclose the drum having suction, nor does it disclose an air stream used to open the envelopes.

BELEC ET AL discloses a method and apparatus for packing envelopes in which envelopes are carried by a vacuum drum (30) with frictional coatings and vacuum apertures. (see Fig 1 and column 3:60-4:25). The envelopes are pulled from the drum by an oscillating suction gripper

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BUTTON ET AL discloses a method and apparatus for packing envelopes in which a flap opening means (28) opens the flap in preparation of inserting items into the envelope by dispensing a compressed air stream to open it (see Fig. 3A and column 7:27-39). An envelope packing assembly is disclosed (see Fig. 7A-7D and column 15:66 - 16:56) in which items are guided into the open envelopes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of MILLER by making the pickup drum a suction-assisted drum, as taught by BELEC ET AL, in order to more positively control the envelopes during the process.

It would further have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of MILLER and BUTTON ET AL by adding an air stream, as taught by BUTTON ET AL, in order to more quickly and completely open the envelopes and to provide them to the control drum in an open and ready-to-fill state.

### ***Response to Arguments***

3. Applicant's arguments filed 9/15/2008 have been fully considered but they are not persuasive.

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4. Applicant states on page 6 of his Response that "The Miller '691 relates to a device which has a design that is apparently somewhat similar to the device of the present invention but which is, in fact, completely different and requires significant number of mechanical movements and components in order to complete each working cycle."

However, Examiner notes that during patent examination of the claims, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). *See also* MPEP § 2111. Moreover, while the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, *this is not the mode of claim interpretation to be applied during examination*. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). *See also* MPEP § 2111.01.

Examiner also notes that the prior art's using "significant number of mechanical movements" may indeed indicate differences in the apparatus, but Examiner maintains the claims in the instant invention read on the combination of the prior art as detailed in the rejection above.

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5. Applicant states on page 6 of his Response that “According to the presently claimed invention, the envelopes are transported in an open condition so that the envelopes can be filled, with the desired item(s) or document(s), immediately upon reaching the introduction zone without requiring an opening step or feature. According to Miller ‘691, there is no need to transport the envelopes in an open condition...”.

However, that teaching is supplied by BUTTON ET AL (see column 15:26-29), and as described in the rejection above, and Examiner maintains it would further have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of MILLER and BUTTON ET AL by adding an air stream, as taught by BUTTON ET AL, in order to more quickly and completely open the envelopes and to provide them to the control drum in an open and ready-to-fill state.

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6. Applicant states on page 7 of his Response that "The Applicant acknowledges that the additional references of Belec et al. '015 and Button et al. '348 may arguably relate to the features indicated by the Examiner in the official action. Nevertheless, the Applicant respectfully submits that the combination of the base reference of Miller '691 with this additional art of Belec et al. '015 and Button et al. '348 still fails to in any way teach, suggest, or disclose the above distinguishing features...".

However, Applicant's argument fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references, since all of the features listed are found in the combination of the prior art and pointed out as they appear in the rejection above.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.

/John R Paradiso/

Examiner John Paradiso: (571) 272-4466

December 19, 2008

/Rinaldi I Rada/

Supervisory Patent Examiner, Art Unit 3721

Additional Phone Numbers:

Supervisor Rinaldi Rada: (571) 272-4467

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